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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,864	05/26/2006	Hideo Suzuki	0171-1277PUS1	7077

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EXAMINER	
SOLOLA, TAOFIQ A	
ART UNIT	PAPER NUMBER
1625	

NOTIFICATION DATE	DELIVERY MODE
09/28/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/580,864	SUZUKI, HIDEO	
	Examiner	Art Unit	
	Taofiq A. Solola	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) 1-9 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) 1,3,5,6,8 and 9 is/are allowed.

6)☐ Claim(s) 2,4 and 7 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 1.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Claims 1-9 are pending in this application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Janssen et al., Recueil, J. Royal Netherlands Chem. Soc. (1979), Vol. 98(7-8), pp. 448-451.

Janssen et al., disclose compound 6e. See page 448.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Janssen et al., Recueil, J. Royal Netherlands Chem. Soc. (1979), Vol. 98(7-8), pp. 448-451.

Applicant claims compounds of formula (2), wherein n is 2-3.

Determination of the scope and content of the prior art (MPEP 2141.01)

Janssen et al., teach compound 6e, wherein n is 1.

Ascertainment of the difference between the prior art and the claims (MPEP 2141.02)

The difference between the instant invention and that of Janssen et al., is in the length of the carbon chain of the compounds. In other words, applicant replaced H in the compound of Janssen et al., with alkyl.

Finding of prima facie obviousness---rational and motivation (MPEP 2142.2413)

However, H and alkyl are art recognized equivalents. *In re Lincoln*, 126 USPQ 477, 53 USPQ 40 (CCPA, 1942); *In re Druey*, 319 F.2d 237, 138 USPQ 39 (CCPA, 1963); *In re Lohr*, 317 F.2d 388, 137 USPQ 548 (CCPA, 1963); *In re Hoehsema*, 399 F.2d 269, 158 USPQ 598 (CCPA, 1968); *In re Wood*, 582 F.2d 638, 199 USPQ 137 (CCPA, 1978); *In re Hoke*, 560 F.2d 436, 195 USPQ 148 (CCPA, 1977); *Ex parte Fauque*, 121 USPQ 425 (POBA, 1954); *Ex parte Henkel*, 130 USPQ 474, (POBA, 1960).

When the difference between compounds is the length of a carbon chain such are adjacent homologs. However, adjacent homologs are prima facie obvious. *In re Henze*, 85 USPQ 261 (1950). Therefore, the instant invention is prima facie obvious from the teaching of Janssen et al. One of ordinary skill in the art would have known to replace H in the compound of Janssen et al., with alkyl at the time the invention was made. The motivation is from knowing that H and alkyl are equivalents and that adjacent homologs would have similar biochemical properties.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Janssen et al., Recueil, J. Royal Netherlands Chem. Soc. (1979), Vol. 98(7-8), pp. 448-451, in view of Morison et al., Org. Chem. 3rd Ed. (1973), pp. 256, and March, Adv. Org. Chem. 2nd Ed. (1977), pp. 708-709.

Applicant claims a process of making compound (4) by reduction (hydrogenation) of compound of formula (7). On page 7, paragraph [0019], applicant asserts the instant

hydrogenation can be performed by any known hydrogenation process, citing several examples as well as applicable catalysts in paragraph [0020]-[0021].

Determination of the scope and content of the prior art (MPEP 2141.01)

Janssen et al., teach hydroboration (catalytic hydrogenation) of compound 6d. See page 449, lines 13-14.

Ascertainment of the difference between the prior art and the claims (MPEP 2141.02)

The difference between the instant invention and that of Janssen et al., is that applicant hydrogenates a triple bond instead of a double bond by Janssen et al.

Finding of prima facie obviousness---rational and motivation (MPEP 2142.2413)

However, Morison et al., teach "addition of hydrogen . . . to alkynes is very much like alkenes." and March, teaches various catalysts for addition of hydrogen to C-C multiple bonds. Most of the catalysts are the same as the catalysts in the instant invention.

Therefore, the instant invention is prima facie obvious from the teachings of the prior arts. One of ordinary skill in the art would have known to combine the inventions of the prior arts at the time the invention was made. The motivation is from the need to hydrogenate a C-C triple bond.

Applicant has done no more than combine separate but well-known inventions. While the combination may perform a useful function it did no more than what they would have done separately. *In re Anderson,* 396 U.S. 57, 163 USPQ 673 (1969) cited in *KSR Int. Co. v. Teleflex Inc*, 550 U.S. ----, 82 USPQ2d 1385 (2007). When a patent simply arranges old elements with each performing the same function it had been known to perform and yields predictable result, the combination is obvious. *In re Sakraida,* 425 US 273, 189 USPQ 449 (1976) cited in *KSR, supra.* A patent for such combination "obviously withdraws what is already known into the field

of its monopoly." *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 187 USPQ 303 (1950), cited in *KSR, supra.*

Allowable Subject Matter

Claims 1, 3, 5-6, 8-9 are allowable over prior arts of record.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

TAOFIQ SOLOLA
PRIMARY EXAMINER

Group 1625

September 14, 2007